

REMARKS

1. Objections

The objections are moot as claim 65 is cancelled and claims 1 and 7 amended as suggested by the Examiner.

2. Definiteness Issues

The rejection is moot as claim 1 has been amended as suggested by the examiner, and claims 6 and 65-68 cancelled.

3. Prior Art Issues

The rejection is moot as claims 65-68 have been cancelled.

4. Unity/Restriction

4.1. The Examiner states in response to section 3 of the last amendment, that withdrawn process claims will be rejoined under MPEP 821.04 if (1) all elected product claims (by implication, which are still pending) are deemed allowable, and (2) the process claims are "commensurate in scope" (e.g., directly or indirectly dependent on) an allowable product claim.

The first condition is satisfied by the present amendments which amend claims 1, 7 and 55 and cancel claims 6 and 65-68.

Withdrawn process claims 33-43 and 55, in groups 5 and 6, are dependent on claim 1 and hence ripe for rejoinder pursuant to MPEP 821.04.

Process claims 46 (group 7) and 48-50 (group 8) were dependent on enzyme claim 10. We believe that these claims should be rejoined under MPEP 821.04 because claim 10 is dependent on claim 1 and is rejoinable under PCT practice (as explained in section 4.2). In any event, the operative entity of claim 48 was a polynucleotide, so we have made 48 dependent on claim 1 rather than claim 10, so MPEP 821.04 is clearly applicable to 48.

4.2. Claim 10 is directed to "an isolated deoxyribonucleoside kinase enzyme encoded by the polynucleotide of claim 1".

The restriction between elected group 1 claims 1-9, 16, 19, 20, 22 and 55) and group 2 (claims 10-15 and 30) was based on a finding of a posteriori lack of unity, i.e., that the common technical feature linking inter alia groups 1 and 2 was taught by Knecht et al. (2003) and therefore fails to qualify as a "special" technical feature.

However, the examiner has indicated that claim 1 is patentable over the prior art, including Knecht, et al. (2003), and claim 10 is dependent on claim 1 and therefore has the special technical features of claim 1 which distinguished over Knecht, et al. (2003) in common with claim 1. Hence the group 2 claims, and for that matter also the still-pending groups 3-8 claims, should be rejoined.

Should the examiner take the position that since claim 1 is drawn to DNA and claim 10 to protein, they cannot be reciting the same special technical features, it is respectfully noted that if the DNA encodes the protein, they are considered to have "corresponding special technical features" under PCT Rule 13, see PCT International Search and Preliminary Examination Guidelines, Section 10.59, Example 39, "Protein and Encoding DNA".

With claim 10 rejoined, the dependent process claims 46 (group 7) and 48-50 (group 8) should be rejoined pursuant to MPEP 821.04 as well as PCT Rule 13 and Pct Administrative Instructions, Annex B, part 1, para. (e)(i).

4.3. Claims 16-21, 31 and 32 (group 3) are directed to vector constructs packaging cell lines, host cells, and related articles. (Note the amendment to claims 31 and 32).

These are combination claims, and under PCT practice are rejoinable since the subcombination (the polynucleotide of claim 1) is allowable, see PCT Administrative Instructions, Annex B, Part 1, para. (c)(i).

4.4. Claim 26 has been cancelled, and claims 27-28 (group 4) made dependent on claim 29. Claims 29-32 were directed to an article comprising a nucleoside analogue and a "source of a deoxyribonucleoside kinase", the source being either the

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nucleotide sequence of claim 1 (per claim 29) or the polypeptide of claim 10 (per claim 30). (We have amended 29 and 30 to avoid the reference to a "source".) Like the group 3 article claims, these are combination claims and should be rejoined.

4.5. Certain species elections were "conditional" because they were responsive to conditional species restrictions, i.e., election requirements applicable only if applicant elected a particular group other than the actually elected group 1. They are relevant now because groups 2-8 are ripe for rejoinder. Claim 1 is generic to the conditional species elections made on page 3 of the election with traverse filed April 29. Hence, the conditional species restrictions should not be applied to groups 2-8 after rejoinder thereof.

Respectfully submitted,

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